

REMARKS

The present application was filed on October 7, 2003 which was also the issue date of U.S. Patent No. 6,629,888 entitled Hidden Image Game Piece (“the ‘888 Patent”). As the present application was filed on the issue date of the ‘888 Patent, it was co-pending with the application which resulted in the issuance of the ‘888 Patent (U.S. patent application Ser. No. 09/480,656). In addition, the present application had co-pendency with the U.S. Ser. No. 09/081,795 (“the ‘795 Application”), now U.S. Patent No. 5,894,367 (“the ‘367 Patent”), from which the ‘888 Patent claimed priority. As was explained in a Preliminary Amendment filed in the present application on October 7, 2003, the ‘795 Application named two joint inventors, namely Thomas L. Barnhart and Joel M. Brooks, who have gone their separate ways.

The undersigned is the attorney for Global Commerce Group, LLC, a Georgia limited liability company, and the owner, by assignment of all right, title, and interest of Joel Brooks, including the rights in any divisional and/or continuation application which derived from U.S. patent application Ser. No. 09/081,795 (*See*, Assignment recorded at Reel 010332, Frame 0120) and the Power of Attorney by Joel Brooks granted to the undersigned.

While the cover sheet of the ‘367 Patent states that Thomas L. Barnhart is the Assignee of the ‘367 Patent, Mr. Barnhart was merely a joint inventor, and was not the Assignee of the ‘367 Patent. In fact, the undersigned brought the foregoing to the attention of **Christopher C. Campbell, Esq. (Reg. No. 37,291)** who filed the Issue Fee Transmittal for the ‘367 Patent. At that time Mr. Campbell told the undersigned that the

placement of Mr. Barnhart's name as Assignee on the Issue Fee Transmittal Sheet was a "clerical error". Nevertheless, and despite requests that he take action to correct the "clerical error" made in his office on a form which he signed and sent to the Patent Office, Mr. Campbell never filed any Certificate of Correction showing that Mr. Barnhart was not the assignee of the '367 Patent, all in violation of his obligations pursuant to 37 C.F.R. § 10.18(c). It is believed by the undersigned that the foregoing acts, by Mr. Campbell, namely, (1) the improper entry of Mr. Barnhart as the "Assignee" of the '367 Patent; and (2) the subsequent refusal by him to correct that error, were both violations of Mr. Campbell's duties pursuant to 37 C.F.R. §10.18 and part of a concerted effort on the part of Mr. Campbell and his client to defraud the joint owner of the invention, Global Commerce Group, LLC.

Thereafter, on January 11, 2000, an attorney in Mr. Campbell's firm (Hunton & Williams) whose name is shown on the REQUEST FORM FOR FILING CONTINUING APPLICATION UNDER 37 C.F.R. § 1.53(b) ("the '888 Transmittal") filed what he called a "continuation" application on which the '888 Patent issued. The '888 Transmittal stated was signed by **Matthew G. Dyor, Reg. No. 45,278** (although in two different locations (Item #14 and under the signature line), Mr. Dyor's name was misspelled as "Matthew G. Pryor"). The '888 Transmittal states (at Item #1):

1. Enclosed is a true copy of the prior complete application as originally filed, including the oath or declaration. [].

In fact, application Ser. No. 09/480,656 (on which the '888 Patent issued) should have been referred to as a *divisional* application rather than as a *continuation* application (See, MPEP §201.06 which states that a "divisional" application is one which claims a

different invention which was disclosed invention in the parent application, while MPEP §201.07 states that a “continuation” application is one which claims the same invention as the parent application). The invention claimed in Ser. No. 09/480,656 and set forth in the ‘888 Patent, was disclosed, but not claimed in Ser. No. 09/081,795, on which the ‘367 Patent was issued.

Accordingly, the ‘888 Patent was filed on an application (Ser. No. 09/480,656) with an incorrectly named inventive entity in that Joel Brooks, a named joint inventor in parent application, Ser. No. 09/081,795 was not named as a joint inventor, and the ‘888 Patent is defective in that it named only Thomas L. Barnhart as an inventor. At no time during the prosecution of the ‘888 Patent was Mr. Brooks’ status as a co-inventor brought to the attention of the PTO, and in fact, it was suppressed by, *inter alia*, the foregoing false allegation in the ‘888 Transmittal.

The present application, which is based upon co-pendency of the same parent application as the one on which the ‘888 Patent was timely filed in an effort to correct the errors made by Mr. Campbell and other attorneys from Hunton & Williams in the filing and prosecution of the ‘888 Patent. Notably, other than some minor changes, the claims set forth in the present Preliminary Amendment are identical to those which issued in the ‘888 Patent. The filing of the present application was intended to result in the issuance of a patent having the same scope as the ‘888 Patent, but to the correct inventive entity, namely *both* Mr. Barnhart and Mr. Brooks, with Mr. Brooks’ rights assigned to Global Commerce Group, LLC, as set forth above.

The present application was filed naming only the undersigned as the attorney of record, with only the undersigned's address as the "correspondence address".

Nevertheless, on August 12, 2005, **Christopher C. Campbell (Reg. No. 37,291)** filed, in the present application, a COMMUNICATION TO PATENT OFFICE REGARDING IMPROPER INVENTORSHIP, together with a purported REVOCATION OF POWER OF ATTORNEY WITH NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS signed by Thomas Barnhart, along with a DECLARATION OF THOMAS L. BARNHART in which Mr. Barnhart alleges that he was the sole inventor of the subject matter of both the '888 Patent and the present application. In fact, nothing could be further from the truth, in that the present application and the application from which the '888 Patent derived were both derived from the same, identical '795 Application from which the '367 Patent derived.

In that Mr. Campbell's filing of the foregoing documents were wholly without the authority, *or knowledge*, of Global Commerce Group, LLC, the assignee of inventor Joel Brooks, they were **unauthorized**. Accordingly, in filing such papers, Mr. Campbell acted solely on behalf of inventor Thomas L. Barnhart, and not on behalf of Global Commerce Group, LLC, the assignee of inventor Joel Brooks. One might readily infer that the joint effort of Mr. Campbell and Mr. Barnhart was to effectively "bury" the present application so that the ill-gotten fruits of their foray into deception in hiding Mr. Brooks' joint inventive contribution to the invention which led to the issuance of the '888 Patent would be retained, all in violation of 37 C.F.R. § 10.18(b).

If, in fact, there was ever a question as to the propriety of the inventorship in the application which resulted in the issuance of the '888 Patent, the proper approach would have been to name ***both*** joint inventors of the parent application, and then seek to delete anyone who was not an inventor of the claimed invention. That was not done, and it is respectfully contended that it was not done to hide the truth, which is that there was a joint invention.

In view of the foregoing violations of 37 C.F.R. § 10.18(b), the undersigned respectfully requests the imposition of various sanctions, as provided for in 37 C.F.R. § 10.18(c), all of which are specifically authorized by MPEP § 410:

- (a) The documents submitted by Mr. Campbell and Mr. Barnhart on October 12, 2005 be removed from the record, § 10.18(c)(2);
- (b) Mr. Barnhart be precluded from filing any further papers in the matter, § 10.18(c)(3); and
- (c) The circumstances involved in (i) the filing of the Issue Fee transmittal in the prosecution of the '367 Patent which improperly named Thomas Barnhart as the assignee of the '367 Patent; (ii) the subsequent refusal of Mr. Campbell to file a corrective notice or Certificate of Correction in the '367 Patent with respect to that deceptive matter; (iii) the improper certification in the '888 Transmittal that the Declaration included therewith (which was incomplete in that the page naming Mr. Brooks as a joint inventor of the parent application was omitted); (iv) the improper, unauthorized filing of the documents referred to above; and (vi) the false

claim of Small Entity Status when Mr. Barnhart was engaged in the licensing of the technology included in the '888 Patent to a Large Entity (namely, WS Packaging, as shown by the License Agreement recorded at Reel/Frame 015035/0633 on August 23, 2004). It is recognized that the grant of a non-exclusive license to a "non-small" entity disqualifies applicant from claiming small entity status. *See Ulead Systems, Inc. v. Lex Computer & Management Corp.*, 351 F.3d 1139, 1142 (Fed. Cir. 2003). *See, also*, 37 C.F.R. 1.27, MPEP 509.02., all be submitted to the Office of Enrollment and Discipline for appropriate action, § 10.18(d).

In view of the foregoing, the Examiner's statement in the outstanding Office Action, "... that the Applicant needs to 'file a correction of filing receipt' or 'a correction in inventorship' in order to remove Mr. Brooks' name as a co-inventor." is incorrect. Instead, as set forth herein the documents improperly entered into the file on August 12, 2005 should be removed, as set forth above.

The Examiner's request for a new Title has been met by the amendment of the Title herein.

Next, the Examiner's "General Comments" appear to state a rejection under 35 U.S.C. § 112, although they did not so state. Nevertheless, the application has been amended to address the issues raised in those General Comments.

Finally, the application stands rejected under 35 U.S.C. § 101 based on statutory double patenting. For the reasons expressed above, it is respectfully submitted that the double patenting rejection is inappropriate in that the application on which the '888

Patent issued was defective for reasons of (i) improper inventorship; (ii) failure to disclose relevant information to the PTO in the course of prosecution of that application; (iii) failure to pay Large Entity fees in that application, all of which cause the '888 Patent to be fatally defective.

In addition, the Examiner properly objected to the claim language in the present application (which language was herein amended to conform to the requirements of 35 U.S.C. § 112). Consequently, there is no longer any basis for the statutory double patenting rejection pursuant to 35 U.S.C. § 101 in that the same invention is not being claimed twice (*See*, MPEP 804 II A.). Specifically, as stated therein:

35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means ***identical*** subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

The MPEP goes on to explain that there is no statutory double patenting under 35 U.S.C. 101 if there is an embodiment of the invention which falls within the scope of one claim, but not the other. In view of the amendments herein, embodiments involving the existence of a game, sweepstakes, or promotion. at the web site to which traffic is being directed would fall within the scope of the claims of the present application, but not within the scope of the claims of the '888 Patent.

Based on the foregoing, the present application is now in condition for allowance, and such action is respectfully solicited.